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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,095	08/26/2003	Bob Cohn	3998355-141582	5894
23570	7590	08/12/2005	EXAMINER	
PORTER WRIGHT MORRIS & ARTHUR, LLP INTELLECTUAL PROPERTY GROUP 41 SOUTH HIGH STREET 28TH FLOOR COLUMBUS, OH 43215				DAVIS, CASSANDRA HOPE
		ART UNIT		PAPER NUMBER
		3611		
DATE MAILED: 08/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/650,095	COHN, BOB
	Examiner Cassandra Davis	Art Unit 3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 16 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5,7-16 and 25-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,7-18 and 25-28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 7-9, 12, 13, 15, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart, U. S. Patent 5,284,365 in view of Miller.

With respect to claim 1 and 12, Stuart teaches a greeting card with and ornament for attachment to a Christmas tree. The ornament comprises a support member (Christmas tree); a plaque (support assembly 44) including a plate member (support member 54) and an adhesive layer (64) on opposite sides of the plate member 54 for adhering the picture (message inserts 42) to the plate member 54; and elastic loop or string 63 for hanging the ornament on the Christmas tree. Stuart teaches "a Christmas ornament hook member could be attached to the string loop member 63 for subsequent attachment to the limb of a Christmas tree for continued enjoyment. (Column 6, lines 52-55).

Stuart also teaches release layers 68 covering the adhesive layer.

Stuart does not teach the ornament having a swivel hanging means.

Miller teaches a Christmas tree ornament swivel barrel type hook.

(See figures 1-7). It would have been obvious to one having ordinary skill in the art at the time this invention was made to support the ornament taught by Stuart with a swivel hook as taught by Miller to provide a means so that the ornament can pivot freely.

With respect to claims 2 and 13, the plaque 44/54 taught by Stuart includes an adhesive layer 64 on opposed sides of the plaque member for adhering a first and second picture 42 thereto, wherein removable cover members 68 protect the adhesive. "During assembly, the cover member 68 is removed and the adhesive layer 74 bonds the primary message insert member 42 to the cylindrical support member 54." (See figures 4-5, column 5, lines 8-40 and claim 22)

With respect to claim 4 and 15, Stuart teaches the plate member can be comprised of a magnetic material. (See column 4, lines 46-53).

With respect to claim 7, Stuart teaches the support member has an inclined vertical member 62 for supporting the ornament on a tabletop. (See column 4, lines 63-68).

With respect to claim 8, Stuart teaches the support member (Christmas tree) is adapted to support a plurality of ornaments.

With respect to claim 9, Miller teaches the barrel type swivel hook.

With respect to claim 3 and 14, since the applicant does not disclose that constructing the plate member of paperboard material solves any stated problem or is for any particular purpose, it appears that construct the plate member of any suitable material as taught by Stuart would perform equally well in retaining the two picture on the opposite side thereof.

With respect to claims 25 and 27, since the applicant does not disclose that plate with edge forming a triangle, star, flower, diamond, oval, or heart solves any stated problem or is for any particular purpose, it appears that constructing the plate of any suitable shape as taught by Stuart would perform equally well in displaying the picture.

Claims 1, 10, 11, 12, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart in view of Ellison, U. S. Patent 6,230,425. Ellison teaches an ornament greeting card comprising an ornament with attachment means 4 and suction cup for attaching the ornament to a support surface such as a window. The ornament can be attached to windows or vertical surfaces by means of attachment means

such as suction cups, releasable adhesive, permanent adhesive, hooks, a refrigerator magnet, etc. It would have been obvious to one having ordinary skill in the art at the time this invention was made to substitute the hook for mounting the ornament taught by Stuart with a magnetic or suction cup attachment device as taught by Ellison to provide a means to removably attach the ornament against a surface.

With respect to claims 26 and 28, Ellison teaches the ornament having an aperture 2 through which the attachment means 4 may be inserted. Ellison also teaches the attachment means such as a "suction cup, a hook, a magnet for a refrigerator, an adhesive or semi-adhesive backed sticker with a peel-off backing, etc, is provided in a form so that a part of the attachment means can project through the aperture". (Column 4, lines 35-50).

3. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart in view of Miller as applied to claim 1 above, and further in view of Ochoa, U. S. Patent 6,113,994. Ochoa teaches a hanging figurine covered in a luminescent substance causing the figurine to glow when positioned in a dimly lit area. (Column 4, lines 40-55).

4. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the ornament taught by Miller and Stuart with a luminescent substance as taught by Ochoa to provide a means to see the ornament in the dark or dimly lit area.

5. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stuart in view of Miller and Ochoa, U. S. Patent 6,113,994. It would have been obvious to one having ordinary skill in the art at the time this invention was made to support the ornament taught by Stuart with a swivel hook as taught by Miller to provide a means so that the ornament can pivot freely. In addition, it would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the ornament taught by Miller and Stuart with a luminescent substance as taught by Ochoa to provide a means to see the ornament in the dark or dimly lit area.

#### *Response to Arguments*

6. Applicant's arguments filed May 16, 2005 have been fully considered but they are not persuasive.

7. In view of the amendment, the rejection of claims 1, 2, 4, 7-9, 12, 13, 15, 23, and 24 under U. S. C. 1-3(s) as unpatentable over Stuart in view of Sniderman has been withdrawn.

8. The applicant argument to the rejection of claims 1, 2, 4, 7-9, 12, 13, 15, 23, and 24 under U. S. C. 1-3(s) as unpatentable over Stuart in view of Miller are not persuasive. The applicant argues that neither Stuart nor Miller provide the required motivation to combine. Specifically, "Stuart nor Miller indicates that it is desirable for an ornament or anything else to pivot freely." The applicant goes on to states that "Miller does not even disclose that the disclosed Christmas ornament swivel even freely pivots". The applicant also argues that Miller does not disclose how the Christmas ornament swivel operates.

9. The examiner contends that Stuart teaches greeting card with a Christmas tree ornament, wherein the ornament comprises a central cylindrical support member 54/44 with adhesive on opposite sides thereof and removable cover members 68 protecting the adhesive. Once the adhesive is removed a first primary insert 42 with Christmas artistic indicia 33 on an outer surface is secured to a first surface of the support member and a second primary insert 42 with Christmas artistic indicia 22 on an outer surface is secured to a second surface of the support member. Stuart also teaches connector member in the form of a "elastic loop or string 63 which is connectable to a Christmas ornament hook for mounting on a

Christmas tree". See column 5, lines 14-35. As recited in column 5, lines 33-35, Stuart clearly teaches attaching the ornament to a Christmas ornament hook for mounting on a Christmas tree. Miller clearly teaches a Christmas ornament swivel hook. The examiner maintains that the hook taught by Miller can be substituted for the hook taught by Stuart.

10. According to the Webster's New Collegiate Dictionary the term swivel means "a device joining two parts so that one or both can pivot freely". (See attachment). The swivel Christmas ornament swivel therefor allows an ornament supported by the swivel to freely pivot.

11. In addition, the applicant argues that present invention is not constructed with any predetermined message or artistic indicia as is the greeting card taught by Stuart. The examiner maintains that Stuart clearly teaches central support member with adhesive on both side thereon and a removable cover layer as stated above. The claims do not appear to positively recite the personal photograph in combination with the device. The examiner contents that since the applicant does not disclose that the indicia on the photograph or the first and second primary insert solves any stated problem or is for any particular purpose, it appears that insert with any suitable indicia thereon would perform equally well.

12. With respect to the rejection of claims 1, 11, and 12 under U. S. C. 1-3(s) as unpatentable over Stuart in view of Ellison, Ellison clearly teaches ornament having an attachment means for hanging the ornament on a support, wherein the attachment means can be a "suction cup, a hook, a magnet for a refrigerator, an adhesive or semi-adhesive backed sticker with a peel-off backing, etc." See column 4, lines 42-47. Since both Stuart and Ellison teaches using a hook to hanging ornament from a support, the examiner contends it would have been obvious to substitute the hook for a suction cup as recited in claim 10 or magnet as recited in claim 11 as taught by Ellison to provide a means to support the ornament from a surface such as a window or metallic surface.

13. The rejection is maintained.

14. Since claim 10 was not properly acted upon in the office action mailed January 14, 2005, this office action will not be made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 571-272-6642. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cassandra Davis  
Primary Examiner  
Art Unit 3611

CD  
August 2, 2005